

## **REMARKS**

This paper is filed in response to the official action dated July 7, 2005 (hereafter, "the official action"). This paper is timely-filed.

Claims 4-6, 8-11, and 15-20 are pending and remain at issue.

In the official action, claims 4-6 and 15-20 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,825,253 to Speyer (hereafter, "Speyer") in view of U.S. Patent No. 4,685,675 to Heiman (hereafter, "Heiman"), U.S. Patent No. 6,193,635 to Webber *et al.* (hereafter, "Webber"), U.S. Patent No. 4,971,305 to Rennex (hereafter, "Rennex"), U.S. Patent No. 4,602,788 to Wendt<sup>1</sup> (hereafter "Wendt"), and in further view of the Choice1 Medical Distributors website advertisement "Hausmann Pulley Weights: Extra 2 lb Weight Plate" (hereafter, "Choice1").<sup>2</sup> Claims 8-11 were rejected under 35 U.S.C. §103(a) as obvious over Webber in view of Heiman, Rennex, Wendt, and in further view of Choice1.

The various bases for the claim rejections will be addressed in the order presented in the official action. Reconsideration of the application, as amended and in view of the following remarks, is solicited.

## **CLAIM REJECTIONS**

The applicants respectfully traverse the rejections of claims 4-6 and 15-20 as obvious over Speyer in view of Heiman, Webber, Rennex, Wendt, and Choice1. The applicants also respectfully traverse the rejections of claims 8-11 as obvious over Webber in view of Heiman, Rennex, Wendt, and Choice1.

A *prima facie* case of obviousness requires the satisfaction of three legal criteria. First, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success in doing so. Third, prior art references, when

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<sup>1</sup> In previous official actions that issued in this application, the examiner relied upon U.S. Patent No. 4,444,396 to Wendt. U.S. Patent No. 4,602,788 to Wendt is a divisional of the '396 patent, and thus the two patent disclosures are identical. Therefore, the arguments already of record in this application regarding the '396 patent remain applicable.

<sup>2</sup> The form PTO-892 attached to the official action provides an August 2003 date for Choice1, which is subsequent to the applicant's filing date. Previously, the examiner asserted that Choice1 was entitled to a 2000 publication date by virtue of its copyright date.

combined, must teach or suggest all of the claim limitations. *See* M.P.E.P. §2142. These criteria have not been satisfied with respect to all pending claims 4-6, 8-11, and 15-20, as explained in more detail below.

Speyer discloses a weight training apparatus comprising a barbell and a set of free weights including a centrally disposed bore and a slot. Speyer does *not* disclose or suggest such a weight training apparatus in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims 4-6, 8-11, and 15-20.

Webber merely discloses a standard cable-type weight training apparatus and a set of plate/weights of standard increments such as 5 pounds, 10 pounds, etc. *See* Webber at column 6, lines 14-17. Webber also generally discloses add-on plates "in various incremental weights of 5 lbs or less." *See* Webber at column 6, lines 43-44. Webber therefore does not disclose or suggest a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims.

In view of the above-noted deficiencies of Speyer and Webber, the examiner turned to Heiman, Rennex, Wendt, and Choice<sup>1</sup>, and extraordinarily diverse collection of an unusually large number of references. Based on the disclosures in these diverse references, the examiner reaches the conclusion that it would have been obvious to modify "Speyer's weight plates into any of an array of sizes from 1/8 ounce up through 45 pounds since the use of such a range of sizes is well known in the exercise art as shown by the representative references cited above and the practice of incrementally adding weight plates of various sizes during exercise is well known in the art." *See* official action at pages 2-3. Similarly, the examiner reaches the conclusion that it would have been obvious "to make Webber's add-on plates into any of an array of sizes as substantially claimed since the use of such a range of sizes is well known in the exercise art as shown by the representative references cited above

and the practice of incrementally adding weight plates of various sizes during exercise is well known in the art.” *See* official action at page 4.

However, the various cited references, whether taken alone or in any proper combination, fail to disclose or suggest the seemingly counterintuitive notion of the present invention in which a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus is provided in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims 4-6, 8-11, and 15-20.

The weights used with standard barbells and cable-type weight training apparatus are typically of at least several pounds in weight and for almost everyone involved in weight training the prevailing notion has been “more is better”, i.e., to increase strength one should try to add individual weights each of at least several pounds to previous maximum weight levels until it can be successfully handled. Understandably, it has not before occurred to those involved in weight training to use the radical alternative of adding individual weights as light as one quarter-ounce and no heavier than two-ounce to previous maximum weight levels where the object is to increase strength beyond previous weight levels, but this technique produces superior, unexpected results by using the counterintuitive approach that “less is better”.

The applicant stands ready to submit a Rule 132 affidavit personally attesting to the superior, unexpected results achieved by using incremental weight training systems and methods in accordance with the claimed invention.

Heiman discloses an adjustably weighted racquet including a plurality of individual weights, which can be removably inserted into bores disposed about an exterior of the racquet frame. Thus, Heiman provides a racquet which “permits variation in distribution and weighting by the user.” *See* Heiman at column 2, lines 5-6. The weights preferably weigh 1/8 ounce. *Id.* at column 4, line 39. Notwithstanding this disclosure of a very light weight, Heiman does not disclose or suggest increasing strength in weight training by surpassing previous maximum weight levels by repeatedly combining such a weight other weights associated with a

weight training apparatus such as a standard barbell or a cable-type weight training apparatus, as recited by all claims 4-6, 8-11, and 15-20. In fact, Heiman does not disclose or suggest any advantage whatsoever that relates to such the use of a small incremental weight with the weights already used in conventional weight training methods. Thus, Heiman does not disclose any motivation for using at least one incremental weight from a group of very small incremental weights including a one quarter-ounce weight, a one half-ounce weight, a one-ounce weight, and a two-ounce weight in combination with a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus.

Webber, Rennex, Wendt, and Choice<sup>1</sup>, whether taken alone or in any proper combination with the other cited references, are similarly deficient for reasons of record. Even Rennex which discloses a smallest weight of 0.2 pounds (i.e., 3.2 ounces), but does not disclose any advantage, misses the point of the present invention by turning to weights in which the smallest is more than one and one half times the *largest* incremental weight in the set claimed by the applicant. By using weights as small as one quarter-ounce, the claimed invention permits weight trainers to record *daily* increases of *small* size that result in great gains over time.

Most importantly, the very small incremental weights in the claimed invention permit the user to accomplish such increases on a regular basis thereby maintaining positive motivation without introducing a significant threat of injury.

For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner has not established that the cited documents themselves would have indicated to one of ordinary skill in the art that the various incremental weights disclosed by Heiman, Rennex, or Wendt in combination with Speyer's barbell and set of free weights or Webber's standard cable-type weight training apparatus would provide a benefit to a user by allowing the user to make *continuous incremental gains in weight training/bodybuilding* without injury or failure. Thus, the record indicates that the examiner combined the references using the appellants' disclosure as a template,

which is improper. *See Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1784. Accordingly, the claim rejections should be reversed.

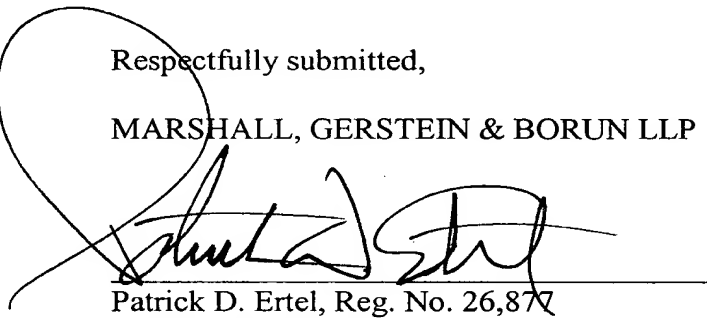
**CONCLUSION**

It is respectfully submitted that the application is now in condition for allowance. Should the examiner wish to discuss the foregoing amendments and/or comments, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

October 7, 2005

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

A large, stylized handwritten signature in black ink, likely belonging to Patrick D. Ertel, is written over a horizontal line. The signature is fluid and cursive, with a large loop at the beginning and a long horizontal stroke extending to the right.

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